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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,911	12/12/2003	A. Wade Cohn	MTV0013US	2291
33031 7590 07/12/2007 CAMPBELL STEPHENSON ASCOLESE, LLP 4807 SPICEWOOD SPRINGS RD. BLDG. 4, SUITE 201 AUSTIN, TX 78759			EXAMINER OVANDO, PABLO R	
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			2609	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/734,911

Applicant(s)

COHN ET AL.

Examiner

Pablo R. Ovando

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

**Claim 10** recites the limitation " providing the automated option" which is dependent on claim 2. However, claim 2 does not mention anything regarding "automated option" and as a result there is insufficient antecedent basis for this limitation in the claim. In the interest of compact prosecution, it is assumed that applicant meant to have claim 10 be dependent on claim 1. Appropriate correction is required.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory).

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product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

**Claims 31-36** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. **Claims 31-36** defines a computer-readable medium embodying functional descriptive material. However, the claim does not explicitly state that it is in executable form and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). That is, the scope of the presently claimed computer-readable medium can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to have the computer-readable medium be executed by a processor.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 2, 6-11, 14-16, 19, 20, 22-26, 28-32, 34-38, 40-42** are rejected under 35 U.S.C. 102(b) as being anticipated by Bateman et al, US Patent 5,884,032 (hereinafter referenced as Bateman)

As to **claim 1**, Bateman discloses a method comprising:

providing an automated option via a first communication channel during first communication between a server and the first communication channel (col. 5 lines 12-22, col. 6 lines 5-19, wherein “automated option” reads on WWW browsers, since a browser has links incorporated and “server” reads on fig. 1 Data net 44 and “first communication” reads on internet access line 6);

determining that a second communication between the server and a second communication channel is related to the first communication (col. 6 lines 15-19, col. 6, col. 7 lines 62-67, col. 8 lines 1-9, wherein “determining” reads on setting up the appropriate time of the call based on the form completed through the browser and “second communication” reads on via fig. 1 telephone 8 and “related to the first communication” reads on solving the conflicting problem initiated by the browser where the live help option was selected and also on the teachings that the channels might be quickly changed from one medium to the other); and via the second communication channel, providing an automated suggestion to select the automated option (col. 7 lines 62-67, wherein “providing an automated suggestion” reads on IVR server being capable of providing help on a variety of topics).

As to **claim 2**, Bateman discloses obtaining a first identifier for first data related to the first communication (Col.6 lines 16-19, wherein "obtaining a first identifier" reads on the user filling out a form identifying information such as their phone number); obtaining a second identifier for second data related to the second communication (col. 7 lines 62-67, it is noted that the IVR can provide help on a variety of topics, also an IVR obtains information from the user and communicates information to the user) ; if the first identifier and the second identifier are the same, using at least one of the first data and the second data to perform an action during at least one of the first communication and the second communication (col. 6 lines 14-25, it is disclosed that the identifier from the first communication and second identifier corresponds to each other by stating that the form filled by the customer through the PC 4 allows the server to call the user's telephone 8).

As to **claim 6**, Bateman discloses providing third data obtained using at least one of the first identifier and the second identifier (col. 7 lines 62-67 and col. 7 lines 1-9, wherein the IVR can help the user in a variety of topics. It is noted that an IVR system will request information as well as provide commands or menus for the user to follow. "Provided third data" reads on the commands or menus that the IVR will generate as a result of the identifier).

As to **claim 7**, Bateman discloses that the action comprises providing a second automated option during at least one of the first communication and the second communication (col. 7 lines 62-27, it is noted that "automated option" reads on IVR call

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back system and "second communication" reads communication using the phone 8 through the PSTN 9 network).

As to **claim 8**, Bateman discloses that the action comprises providing a second automated suggestion to select a second automated option provided during at least one of the first communication and the second communication (col. 7 lines 62-27 discloses that an IVR is used to provide help on a variety of topics, it is inherent that the IVR system will provide various suggestions during the process in order to gather and correlate the correct data).

As to **claim 9**, Bateman discloses the first communication channel is of a first type (fig. 1 phone 8 and PSTN 9), the second communication channel is of a second type (fig. 1 PC 4 and element 28), and the first type and the second type are different.

As to **claim 10**, Bateman discloses that providing the automated option comprises determining the automated option by evaluating at least one of the first data and the second data (col. 6 lines 14-22 and col.7 lines 62-67 disclose that when the user fills out the form on the browser, the server will determine what the user's input was with regards to preferences when the user desires to be contacted. With that information the server would know whether to link the call with an IVR at the precise moment or at a later time).

As to **claim 11**, Bateman teaches that the first data are unavailable via the second communication channel, and the second data are unavailable via the first communication channel (col. 6 lines 6-13 and col. 7 lines 62-66 discloses that the information from the pc 4 is communicating through web server 28, and the phone 8 is

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communicating through the PSTN 9. It is inherent that each communication artifact communicates through a separate path; therefore the data will not travel on separate communication channels).

As to **claim 14**, Bateman discloses that a first one of the first and second communication channels is a telephone channel (fig. 1 phone 8 and PSTN 9); and a second one of the first and second communication channels is a web channel (fig. 1 PC 4 and element 28).

As to **claim 15**, Bateman discloses that the second communication channel comprises a voice application, and the providing the automated suggestion is performed by the voice application (col. 8 lines 1-8, wherein "voice application" reads on enhanced applications such as home shopping systems and it is inherent that the application will provide suggestion or different menus according to the user's selection).

As to **claim 16**, Bateman discloses that the voice application interacts with an interactive voice response application to receive a voice signal (col. 7 lines 62-67).

As to **claims 19, 20 and 22-24**, Bateman anticipates the system for the reasons given in claims 1, 2, 6-8 respectively. All means for function elements of claims 19-24 are carried by interaction between software/hardware as disclosed by Bateman in fig. 1.

As to **claims 25, 26 and 28-30**, Bateman discloses a system corresponding to the method steps of claims 1, 2, 6-8 respectively (see rejection of claims 1, 2, 6-8 respectively).



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As to **claims 31, 32 and 34-36**, Bateman discloses a system carried by interaction between software/hardware, and therefore it would be inherent that a program stored (intended language) in a computer readable medium is stored in the software/hardware corresponding to the method steps of claims 1, 2, 6-8 respectively (see rejection of claims 1, 2, 6-8 respectively).

As to **claims 37, 38 and 40-42**, Bateman discloses a computer system carried out by software/ hardware and therefore it would be inherent that the system has a processor for executing instructions and a memory to store instructions. Additionally the system corresponds to the method steps of claims 1, 2, 6-8 respectively (see rejection of claims 1, 2, 6-8 respectively).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 3, 4, 5, 12, 13,17, 18, 21, 27, 33, 39** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bateman in view of Klein, US Patent 6,279,125 (hereinafter referenced as Klein).

As to **claim 3**, Bateman meets all the limitation with the exception of disclosing that at least one of the first data and the second data comprises a diagnostic code, and the action comprises providing second information decoded from the diagnostic code.

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Klein discloses a system in the same field of endeavor that diagnosis computer problems by providing diagnostic information from the computer to an agent or automated diagnostic system (col.6 lines 5-12, abstract lines 1-3) through the phone to diagnose the problem and find relevant troubleshooting information (col. 5 lines 37-49, col. 6 lines 5-12), wherein "first data" reads on information sent through the phone and "second information" reads on the data obtained from the audio input/output device used to report diagnostic data (col. 6 lines 8-12). It would have been obvious for someone of ordinary skill in the art at the time of the invention was made to apply the teachings of Klein in Bateman's method for the purpose of providing the agent or automated diagnostic system information about the status of the computer. Having the agent or automated diagnostic system know the status of the computer would lead to determining the cause of error faster and more efficiently.

As to **claim 4**, Klein discloses that the second information comprises at least one of telemetry data, and diagnostic information (col. 6 lines 5-12, wherein the second information is the audio from the computer going to the agent or automated diagnostic system to provide the proper diagnosis).

As to **claim 5**, Klein discloses providing the second information for viewing (col. 6 lines 12-21, wherein the agent or automotive diagnostic system explains information to the user and the user is able to view that information on the computer).

As to **claim 12**, Klein discloses that at least one of the first data and the second data comprises diagnostic information for a problem with the problem entity (col. 6 lines 8-12).

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As to **claim 13**, Klein discloses that at least one of the first data and the second data comprises information for identifying the problem entity (col. 6 lines 8-12, wherein the data sent comprises the problem entity).

As to **claim 17**, Bateman teaches using two different channels, which provide automated options to communicate information. However, it does not teach that the automated option is a solution to a problem with a problem entity, and the first communication and the second communication provide data about the problem with the problem entity. Klein teaches diagnosing problems through a communication channel with a technician or an automated diagnostic system (col. 6 lines 8-11 and lines 22-36, abstract). It would have been obvious to someone of ordinary skill in the art at the time of the invention was made to modify Bateman's method with Klein's teachings of sending diagnostic information through two different channels for the purpose of gathering data from a variety of resources.

As to **claim 18**, Bateman teaches gathering information through different channels. Klein discloses gathering data related to a problem. Therefore, it would have been obvious to someone of ordinary skill in the art to modify Bateman's method with the teachings of Klein for the purpose of enhancing a customer's online experience when using the applications disclosed in Bateman.

As to **claims 21, 27, 33, 39**, the combination of Bateman and Klein meets all the limitations. Claims 21, 27, 33, 39 correspond to the method steps of claim 3 (see rejection of claim 3).

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### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shtivelman, Patent number 6,393,015 discloses a system for coordinating a the communication between an agent and a user.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pablo R. Ovando whose telephone number is 571-272-9752. The examiner can normally be reached on M-F 7:30 am to 5:00pm, EST, Alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Pendleton can be reached on 571-272-7527. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

P.O.

  
BRIAN TYRONE PENDLETON  
SUPERVISORY PATENT EXAMINER